

Amendment and Response under 37 C.F.R. 1.116

Applicant: Daniel R. Marshall

Serial No.: 09/759,867

Filed: January 12, 2001

Docket No.: 10002307-1

Title: PORTABLE INFORMATION STORAGE MODULE FOR INFORMATION SHOPPING

REMARKS

The following remarks are made in response to the Final Office Action mailed September 14, 2005. In that Office Action, the Examiner rejected claims 1-8, 11-30, and 34 under 35 U.S.C. §103(a) as being unpatentable over Treyz et al., U.S. Patent No. 6,587,835 ("Treyz") and Gibson et al., U.S. Patent No. 5,557,596 ("Gibson"). Claims 9, 10, 31-33, and 35-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Frenkiel et al., U.S. Patent Publication No. 2002/0198958 ("Frenkiel") and Gibson, and further in view of Gioscia et al., PCT Publication No. WO00/30117 ("Gioscia").

With this Response, claims 9, 31, and 35 have been cancelled without prejudice and claims 1, 10, 30, 31, and 34 have been amended. Claims 1-8, 10-30, 32-34, 36, and 37 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §103 Rejections

Claims 1-8, 11-30, and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Treyz et al., U.S. Patent No. 6,587,835 ("Treyz") and Gibson et al., U.S. Patent No. 5,557,596 ("Gibson"). Claim 1 has been amended to include the limitation from previous dependent claim 9, claim 30 has been amended to include the limitation from previous dependent claim 31, and claim 34 has been amended to include the limitation from previous dependent claim 35, all of which have been rejected as being unpatentable over Treyz, Frenkiel et al., U.S. Patent Publication No. 2002/0198958 ("Frenkiel") and Gibson, and further in view of Gioscia et al., PCT Publication No. WO00/30117 ("Gioscia"). Therefore claims 1, 31, and 34, and the claims depending from these claims will be addressed below with regard to the rejections to previous claims 9, 31, and 35, respectively.

Applicant submits that Treyz and Gibson, either alone, or in combination, fail to teach or suggest the invention as recited in independent claim 15. The Examiner admits that Treyz fails to disclose a memory component configured having dimensions no larger than one square millimeter and capable of storing gigabytes of data. (Office action, page 3). There is no teaching or suggestion in Gibson or Treyz to combine the ultra-high density storage device of Gibson with the handheld computing device of Treyz. Gibson is silent on the use of the ultra-high density storage device in a handheld computer device. Treyz merely states that

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storage 72 may include random-access memory (RAM) 74, read-only memory (ROM), and any other suitable volatile or non-volatile memory or storage device 78. (Col. 15, lines 8-10).

Treyz is silent on using an ultra-high density storage device.

In view of the above, Applicant respectfully requests that the rejection of claim 15 under 35 U.S.C. §103(a) be withdrawn and claim 15 be allowed.

Dependent claims 16-28 further define patentably distinct independent claim 15. Accordingly, these dependent claims are also believed to be allowable over the cited references. Therefore, withdrawal of the rejections and allowance of claims 15-28 is respectfully requested.

Applicant respectfully submits that independent claim 29 is also allowable for the same reasons as discussed above with reference to claim 15. Therefore, withdrawal of the rejections and allowance of claim 29 is respectfully requested.

Claims 9, 10, 31-33, and 35-37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Treyz, Frenkiel et al., U.S. Patent Publication No. 2002/0198958 ("Frenkiel") and Gibson, and further in view of Gioscia et al., PCT Publication No. WO00/30117 ("Gioscia"). The limitations of previous dependent claim 9 have been included in amended independent claim 1, the limitations of previous dependent claim 31 have been included in amended independent 30, and the limitations of previous dependent claim 35 have been included in amended independent claim 34. Applicant submits Treyz, Frenkiel, Gibson, and Gioscia, either alone, or in combination, fail to teach or suggest the invention as recited by amended independent claims 1, 30, and 34.

Amended independent claim 1 recites wearing the housed portable storage module on or about a body of a user and amended independent claims 30 and 34 recite wearing the portable storage module about a body of a user. While Gioscia discloses a device that may be worn on the wrist or clipped to the clothing of a purchaser, Gioscia does not disclose a device capable of storing both audio and visual media. In addition, Gioscia does not disclose storing gigabytes of data in less than one square millimeter and is silent on the use of an ultra-high density storage device. Gibson is silent on the use of the ultra-high density storage device in a handheld computer device. Treyz merely states that storage 72 may include random-access memory (RAM) 74, read-only memory (ROM), and any other suitable volatile or non-volatile memory or storage device 78. (Col. 15, lines 8-10). Treyz is silent on

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using an ultra-high density storage device.

In addition, the portable entertainment media storage module limitations of amended independent claims 1, 30, and 34 have many advantageous features not taught or suggested by the cited references. Foremost, the module includes a high capacity storage memory component, such as an atomic resolution storage device, for storing large amounts of information such as one or more books, music CDs, and/or movies, etc. in an extremely small space. This feature permits conveniently transporting an entertainment packet (e.g., a book) in virtually hands-free and almost weightless manner relative to transporting conventional formats such as a printed volume. The entertainment packet can be worn about the body such as in a neck pendant, wristwatch, and cell phone, or simply placed in a pocket of a shirt or pants. Moreover, more than one entertainment media can be handled at once with the module. Accordingly, a user can simultaneously carry and access a movie, music CD, and book, among other items from embodiments of a module having the limitations of amended independent claims 1, 30, and 34, all within a single, lightweight small housing such as a pendant. Handling and consuming entertainment media can have remarkable changes in convenience and enjoyment with this feature.

Furthermore, there is no teaching or suggestion in Treyz, Frenkiel, Gibson, or Gioscia to combine the handheld computing device of Treyz, the system for delivering information of Frenkiel, the ultra-high density storage device of Gibson, and the personal music device of Gioscia and arrive at the invention recited by amended independent claims 1, 30, and 34.

In view of the above, Applicant respectfully submits that the amended independent claims 1, 30, and 34 are allowable over the cited references. Dependent claims 2-8, 10-14, 32, 33, 36, and 37 further define patentably distinct amended independent claims 1, 30, or 34. Accordingly, these dependent claims are also believed to be allowable over the cited references. Therefore, withdrawal of the rejections and allowance of claims 1-8, 10-14, 30, 32-34, 36, and 37 is respectfully requested.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-8, 10-30, 32-34, 36, and 37 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-8, 10-30, 32-34, 36, and 37 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Patrick G. Billig at Telephone No. (612) 573-2003, Facsimile No. (612) 573-2005 or Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Respectfully submitted,

Daniel R. Marshall,

By his attorneys,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2003
Facsimile: (612) 573-2005

Date: 11-8-2005
PGB:bc



Patrick G. Billig
Reg. No. 38,080

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via telefacsimile to Examiner Peyton, Group Art Unit 2182, at Fax No. (571) 273-8300 on this 8 day of November, 2005.

By 
Name: Patrick G. Billig